REMARKS

The application, having been granted a priority date under 35 U.S.C. §119 of 12 May 2000 derived from France patent application 00480043.9, was filed in the United States on 24 April 2001 with ten claims. In the first Examiner's Office Action mailed 02 January 2004, the Examiner objected to the abstract. The Examiner rejected claims 1-10 and claims 4-5 under 35 U.S.C. §112, second paragraph. The Examiner also rejected claims 1-10 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,920,316 entitled TASKBAR WITH START MENU to Oran et al. (Oran '316) in view of U.S. Patent No. 5,515,496 entitled COMPUTER SYSTEM WITH DIRECT MANIPULATION INTERFACE AND METHOD OF OPERATION SAME to Kaehler et al. (Kaehler '496).

Applicant has amended the specification and the claims. Applicant has added new claims 11-20. In amending the claims and adding new claims, Applicant has not added new matter. Support for the "focus buoy being displayed at a location on or beside its respective window" is given in the original specification on page 4, lines 26-28 which state, "It must be noted that the buoy might be displayed at any location of the window and even beside the window." Support for the "focus buoy not visible when its respective window is not visible" is given in the original specification in Figures 2B and 2C. Support for the "real" location of claim 3 is given in the original specification on page 5, lines 12-14 which state, "It must be noted that an alternative location (row, column) can be also registered for each focus buoy further to the real location." Support for the "little" window in claims 4 and 5 is discussed below. Support in the originally filed specification for new claims 11-20 are given on page 6 through page 7 and in the figures.

Claims 1-20 are pending in the application.

The Objection to the Abstract

Applicants have amended the Abstract to removing the offending language "means." Applicants respectfully request the Examiner to review the amended Abstract.

The Rejections under 35 U.S.C.§112, second paragraph

The Examiner rejected claims 1-10 under 35 U.S.C.§112, second paragraph stating that the term "shaking" is a relative term that renders the claims indefinite. The Examiner states that the term "shaking" is not defined by the claim and that the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonable apprised of the scope of the invention. The Examiner asserts that "shaking" is a general word that can be construed in numerous different ways; but for the purpose of examination, the word "shaking" was construed as "any moving of the mouse."

Respectfully, Applicant traverses. One of ordinary skill in the art knows what "shaking" means. Absent intrinsic evidence of what a term in a claim means, principles of claim construction allow that the first tier of extrinsic evidence permitted is that words be given their common meaning. The most common meaning of a word is presented as the first definition of a word in a dictionary. According to the Encarta World English Dictionary, St. Martin's Press, New York, 1999 at page 1645, "shake" is defined as "1. MOVE BACK AND FORTH to move or make something or somebody move back and forth or up and down in short quick movements." When considered in the context of the entire specification, one of ordinary skill in the art would know that "shaking" the mouse means to move the mouse back and forth in short quick movements. What else can it mean? If the Examiner wishes to suggest another term, Applicant invites the Examiner to proffer another term.

The Examiner further rejected claims 4 and 5 under 35 U.S.C. §112, second paragraph because the term "small window" is used to mean "message box", while the accepted meaning is "a portion of the screen that can contain its own document." Respectfully, Applicant requests clarification from the Examiner. Is it the "message box" or is it the "small window" that the Examiner says has the accepted meaning as a portion of the screen that can contain its own document? What is the source of this accepted meaning? Who accepts this meaning?

In any event, Applicant amended the claim to remove the offending language "small" and substituted the word "little." In amending the claim, Applicant has not added new matter because the originally filed specification at page 6, lines 2-5, defines the "little" window: "a little window such as windows 34, 36, and 38 [referring to Figure 2D] respectively associated with the focus buoys 24, 28 and 32, containing a title relating to the corresponding window." One of skill in the art can read the claim in view of the specification and determine the scope of the invention: the window is little to contain the title of the corresponding window associated with the focus buoy.

The Rejection of claims 1-16 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-10 as being obvious over Oran '316 in view of Kaehler '496. Oran '316 teaches the Microsoft taskbar with which we are familiar; the taskbar includes visual indicators for each application that has an active window. By clicking on one of the visual indicators, a user invokes a pullup/pulldown context menu for the particular application from which to choose several options, such as to "close," "minimize," or "maximize" the application and/or window. Kaehler '496 teaches a method to change affordances of an icon by an edit-and-use mode. An affordance is a special place or indicator displayed on or adjacent a button by which to modify the function of the button, Kaehler '496 at column 3, lines 2-5. Kaehler '496 further teaches that the edit-and-use mode uses a select box associated with an object such as an icon. When the select box is selected, edit

handles, each of which modify the object, appear. By selecting a particular edit handle, the object is modified in accordance with the selected edit handle. Kaehler'496 further teaches that the edit handles can be made to appear by gesturing the mouse, i.e., by wiggling the mouse on/near the select box of an object.

The Examiner asserts that Oran '316 teaches the elements of the claimed invention. The Examiner admits, however, that Oran '316 does not teach the ability to display the buoy at each location defined in response to shaking or moving the mouse. The Examiner then reasons that it would have been obvious to one of ordinary skill in the art at the time of the invention to use Kaehler '496's teaching and modify Windows NT, to include an option where the user has to wiggle the mouse to instigate an action of displaying all the buoys or icons in order to give the user the ability to see all the open windows without having to click any of the mouse buttons.

In response, Applicant amends independent claim 1, and inserts into independent claims 11 and 16 language that particularly points out and distinctly claims that each focus buoy [is] not visible when its respective window is not visible, and that the focus buoy is on or beside its associated window.

Applicant further asserts that, absent Applicant's teaching, one of skill in the art would not be inclined to modify Oran '316 with the teaching of Kaehler '496; that is, there is no suggestion in either Oran '316 or in Kaehler '496 for the proposed modification. Oran '316 teaches the taskbar of the Windows operating system wherein each open application is represented by a visual indicator on the taskbar. In Oran '316, the taskbar serves as a centralized location for identifying all of the currently active tasks within the system, *see* Oran '316 at column 6, lines 20-22, so the visual indicators are always located on the taskbar and the taskbar is always anchored at a fixed location on the user interface, *see* Oran '316 at column 5, lines 10-11. In contrast, Applicant's focus buoys are located on or besides its associated window; thus there may be multiple focus buoys located all over the display, *see, e.g.,* Figure 2D of Applicant's application.

Another claimed distinction between Oran '316 and Applicant's invention is that, in contrast to Oran '316 wherein the visual indicators are always visible even if its window is minimized and/or not visible, the focus buoys of Applicant are not visible when the window is not visible. Therein lies the reason why one of skill in the art would not look to Oran '316 and shake the mouse on the taskbar to find out what window/applications are open. Oran '316 at column 12, lines 1-9 states:

> As was discussed above, *the taskbar is designed to be consistently visible such that it is not readily obscured by opened windows* .... [w]hen a window for a word processing program is maximized, the maximized word processing window does not obscure the taskbar. This is achieved by setting the working area available to the application window to exclude the taskbar region. The taskbar does not cover any part of the word processing window, rather their borders merely meet. [Emphasis added, reference numerals removed]

Thus, in Oran '316, the taskbar having the visual indicators of the open applications are always visible - so why would one of skill in the art shake the mouse over the taskbar to make the visual indicator appear?

Oran '316 does state that the taskbar can be hidden, *see* Oran '316 at column 9, lines 12-21, by checking an "Auto hide" check box on a property sheet. The taskbar reappears when there are no more windows open or by unchecking the "Auto hide" check box. Absent the Examiner's hindsight, though, there simply is no suggestion that a hidden taskbar can be made to reappear by merely shaking the mouse. Indeed, Oran '316 teaches away from Applicant's invention because in Oran '316 all the applications must be closed before the hidden taskbar reappears; in stark contrast, the purpose of Applicant's invention is to inform the user of the open or active windows/application.

Respectfully, the combination of Oran '316 and Kaehler '496 cannot render Applicant's claimed invention as obvious under 35 U.S.C. §103(a) because no matter how hard you shake the mouse in Oran '316, focus buoys of the open applications do not appear.
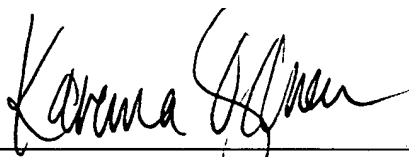
Conclusion

Applicants have amended the specification and claims 4 and 5 to remove the objectionable language. Applicant has further traversed the rejection of the claims under 35 U.S.C. §112, second paragraph because one of skill in the art would know what "shaking" means in the context of the specification. Applicant has amended the claims and has added new claims indicating that a focus buoy is located on or beside its respective window and that the focus buoy is not visible when its respective window is not visible. Applicant requests the Examiner to reconsider and remove the rejection of claims 1-10 under 35 U.S.C. §103(a) in view of Oran '316 over Kaehler '496 and pass the application to issuance. The Examiner is further invited to telephone the Attorney listed below if he thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,
Patrick Gaston Joseph Boeuf

Date: 30 March 2004   By

Karuna Ojanen
Registration No. 32,484
(507) 285-9003 voice
(507) 252-5345 fax

IBM Corporation
Intellectual Property Law Dept. 917
3605 Highway 52 North
Rochester, MN   55901-7829